

DOCKET NO.: 190453.01/MSFT-0765
Application No.: 10/091,276
Office Action Dated: December 2, 2005

PATENT

REMARKS

In response to the Office Action dated December 2, 2005, Applicants respectfully request reconsideration based on the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1-25 are pending. Claims 1-25 have been rejected. Claims 1, 16, 21 and 24 are independent claims from which claims 2-15, 17-20, 22-23 and 25 respectively depend.

§103(a) Rejections

Claims 1-14, 16-20, 24 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Austin (U.S. Pat No. 6,701,315 B1) in view of Stefik (U.S. Patent No. 5,715,403) and further in view of Martin (U.S. Patent No. 5,618,232).

Applicants respectfully submit that claim 1 and the claims that depend therefrom are patentable because Austin, Stefik and Martin are improperly combined. Furthermore, even if properly combined Austin, Stefik and Martin, alone or in combination do not disclose or suggest all the features of Applicants claim 1. Claim 1 recites:

A method for providing archived material comprising:
retrieving a first instance of archived material comprising a plurality of items, the plurality of items comprising at least one requested item comprising text and at least one image and at least one accompanying, non-requested item; and
determining that the at least one accompanying, non-requested item of the plurality of items is substitutable;
selecting a new item according to at least one rule, *the at least one rule comprising selecting the new item based on a geographical location associated with a requestor of the archived material; and*
generating a second instance of archived material by replacing the at least one substitutable item in the first instance with the new item.

(emphasis added).

Austin is directed to a system and method for delivering information such as printed material to a user in one or more preferred delivery media, based on a user profile. Austin does not disclose or suggest at least "selecting a new item according to at least one rule, the at least one rule comprising selecting the new item based on a geographical location associated with a requestor of the archived material" – the type of delivery media is unrelated to geographical location. Stefik is directed to a system for controlling the use and distribution of digital works. A digital work is accompanied by usage rights that determine how the work

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can be used and/or distributed. Digital rights are unrelated to geographical location. Martin is directed to a dual mode gambling/gaming device that is configurable as a gaming device or as a gambling device, depending on location. (Gambling is illegal within three miles of shore in some jurisdictions.) Once outside the area in which gambling is illegal, the device can switch from "gaming mode" to "gambling mode". Martin is improperly combined with Austin and Stefik because an ordinary person of skill in the art would not be motivated to look to the gaming industry for solution to determining what to substitute for a substitutable non-requested item of archived material. Moreover, even supposing the combination were proper, Martin does not disclose or suggest at least the italicized features of Applicants' claim 1. In Martin, the material presented to the user is wholly substituted according to the geographic rule, whereas in Applicants' claim 1, only the substitutable item is replaced according to the geographic rule. Independent claims 16 and 24 from which claims 17-20 and claim 25 respectively depend include analogous features. Therefore, Applicants respectfully submit that independent claims 1, 16, and 24 and their dependent claims are patentable and request the withdrawal of the rejections of these claims.

Claims 15, and 21-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Austin, Stefik and Martin and further in view of Fields et al. (U.S. Patent No. 6,704,797 B1). Applicants respectfully submit that claim 15 is allowable because Austin, Stefik, Martin and Fields are improperly combined and furthermore, even if properly combined, do not disclose or suggest all the features of Applicants claim 1, from which claim 15 depends, for the reasons presented below with respect to claim 21. Claims 1 and 21 include analogous features.

Applicants respectfully submit that claim 21 and the claims that depend therefrom are patentable because Austin, Stefik, Martin and Fields are not properly combined. Martin is improperly combined with Austin, Stefik and Fields because an ordinary person of skill in the art would not be motivated to look to the gaming industry for solution to determining what to substitute for a substitutable non-requested item of archived material. Moreover, even supposing the combination were proper, whether alone or in combination, Austin, Stefik, Martin and Fields do not disclose or suggest all the features of Applicants claim 21. Claim 21 recites:

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A computer-readable medium having stored thereon a data structure associated with an item, the item comprising a portion of a document that appears on a page, the data structure comprising:

a first data field comprising category data of the item, *the item comprising a non-requested item accompanying a requested item, wherein the category data describes a type of item, the type of item comprising one of: text, an image, and an advertisement;*

a second data field comprising geometric data of the item, wherein the geometric data describes one of a physical location of the item within a page and the size of an item; and

a third data field comprising relevancy data, wherein the relevancy data comprises *a geographical location associated with a requestor of the item.*

As discussed above, Austin is directed to a system and method for delivering information to a user in one or more preferred delivery media unrelated to geographical location. Stefik is directed to a system for controlling the use and distribution of digital works. A digital work is accompanied by usage rights that determine how the work can be used and/or distributed. Martin is directed to a dual mode gambling/gaming device that is configurable as a gaming device or as a gambling device, depending on location. Once outside the area in which gambling is illegal, the device can switch from "gaming mode" to "gambling mode". Austin, Stefik and Martin, alone or in combination do not disclose or suggest at least the italicized features of Applicants' claim 21. In Martin, the material presented to the user is wholly substituted according to the geographic rule, whereas in Applicants' claim 1, only the substitutable item is replaced according to the geographic rule.

Fields does not cure the deficiencies of Austin and Stefik. Fields is directed to a system and method for protecting images, resulting in the selective distribution of one of multiple versions of an original image according to a set of rules unrelated to geographical location. Fields does not disclose or suggest at least the italicized features of Applicants' claim 21. Hence, Applicants respectfully submit that claim 21 and its dependent claims are patentable and request the withdrawal of the rejections of these claims.

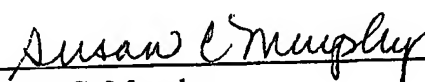
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Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the present Application is in condition for allowance. Withdrawal of the rejections of the claims and an early allowance is earnestly solicited.

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